



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 02 2003

GROUP 3600

In re Application of: WINCHESTER, Richard M.)
Filed: 08/27/01)
Serial No.: 09/940,208) Art Unit: 3634
For: Construction Layout Stripping) Examiner: Strimbu, Gregory
Having a Plurality of Pairs of Uprights)
Thereon)

Commissioner for Patents
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EK105781920US

RESPONSE TO FINAL OFFICE ACTION

The Applicant hereby responds to the final office action mailed on June 3, 2003 ("Final OA"). Per a teleconference with the Examiner on October 1, 2003, the primary references cited by the Examiner as the bases for rejection of the pending claims were Lafrance and Salato. Lafrance and Salato were raised by the Examiner for the first time during the prosecution of this CIP in the Final OA. The Applicant therefore asks the Examiner to withdraw the final rejection in the Final OA as premature. See MPEP at § 7.06.07(a) (regarding impropriety of a final rejection based on newly cited art such as Lafrance) and § 7.06.07(d) (regarding withdrawal of a premature final rejection). The Examiner apparently concedes the "new" nature of his objections. Final OA at p.9 (arguing that the affidavits submitted by Applicant are moot in light of the "new grounds of rejection").

Lafrance is an improper reference in view of the Section 131 affidavit of the Applicant submitted herewith. The 131 affidavit establishes that the elements of the invention as embodied in the claims were conceived by the inventor in September 1994,¹ well before Lafrance's effective

¹ The Applicant conceived the invention while working on a custom home. The fact that the Applicant was building a custom home at that time, which was the circumstance giving rise to his inventive spark, can be established by extrinsic evidence.

date – December 17, 1998.² Exhibit “A” to the 131 affidavit shows various materials of construction,³ various spacing units,⁴ uprights.⁵ Lafrance is therefore not a proper reference. All claims rejected in whole or in part based on Lafrance should be allowed to pass to issue. Table 1 summarizes the claims rejected in whole or in part based on Lafrance. In view of the fact that Lafrance is an improper reference, claims 2-5 and 7-15 should be allowed to pass to issue once appropriate amendments, if any, to overcome § 112 issues are made.⁶

² Assuming Lafrance is entitled to priority based on the earliest of two abandoned parent applications.

³ “Metal or Vinyl” noted on page 2a.

⁴ “16” or 24” centers” noted on page 2a.

⁵ Described as “elevated spacers” and shown in a figure on page 3a.

⁶ Claims 1 and 6 were rejected solely based on Salato, and that issue is addressed below. In short, while the Applicant does not agree that Salato anticipates claim 1, he is willing to accept that proposition for purposes of expediting the prosecution. However, the rejection of claim 6 as being anticipated by Salato is improper for the reasons noted below.

TABLE 1

Claims Rejected in Whole or Part Based on Lafrance

CLAIM	REJECTIONS	BASES
3, 5-12	102(3)	Anticipated by Lafrance.
2	103(a), Final OA at p.6 and 7	Obvious over Lafrance in further view of Hanson who discloses a stripping having ribs. ⁷ Obvious over Lafrance in view of Salato and further view of Hanson disclosed ribs.
3	103(a), Final OA at p.8	Obvious over Lafrance in view of Salato in further view of Lamblet who discloses a strip comprising two bonded layers (elastic and non-elastic).
4	103(a), Final OA at p.6 and 8	Obvious over Lafrance in further view of Silver et al who disclose the use of removable, pressure-sensitive adhesive to position the construction elements before affixing them in place. Obvious over Lafrance in view of Salato in further view of Silver et al. who disclosed an adhesive.
13, 14	103(a), Final OA at p.6 and 8	Obvious over Lafrance, which the examiner argued would "inherently lead to the method steps" of these claims. Alternatively, obvious over Lafrance in view of Salato.

Claim 1 and 6 are rejected as anticipated by Salato. The Applicant disagrees with the Examiner in this assessment. Salato does not have "pairs of uprights," defining a spacing interval for each construction member. Rather, each construction member shares an upright with its neighbor construction member. That is, in the present invention, there are two uprights for each construction

⁷ Applicant does not concede that use of ribs for the purpose of facilitating the cutting of the strip would have been obvious in view of Hanson, but it is not necessary to reach that issue, since the Examiner only rejected claims in view of Hanson when combined with Lafrance, which Applicant submits is not a proper reference since Applicant's conception predates Lafrance's filing date.

member, thus the claim for a "pair" of uprights. See, e.g., claim 1. In Salato, there is only one upright per construction member. It is true that each construction member in Salato has an upright on either side of it, but each of those uprights is shared in common with a neighbor construction member. See, e.g., Salato at Fig. 1 and claim 1. Thus the ratio of construction members to uprights is 1:2 in the present invention and 1:1 in Salato. Claim 6 teaches a variety of spacing intervals on the same strip. Nowhere does Salato teach this feature. The Examiner attempts to avoid this distinction by noting that each interval in Salato is "x," so a variety of intervals could be accomplished by various integer multipliers of the "x" interval. True, but only a partial analysis. In the present invention, intervals of (for example) 16 and 24 inches are noted as commonly desirable for construction elements. 24 inches is not an integer multiplier of 16 inches, and could only be achieved by a 1.5 multiplier. This Salato does not teach. In fact, a multiplier of 1.5 in Salato could be achieved only by cutting off one of the spacers. The Applicant respectfully asks the Examiner to withdraw the rejection of claim 6 as anticipated by Salato.

The Applicant generally accepts the Examiner's objections regarding the form of the abstract. Appropriate amendments to overcome the objections are provided below. The Applicant disputes the Examiner's assertion that the phrase "at fixed intervals" is confusing. Given its position immediately following the phrase "pairs of uprights," rules of English usage dictate that it modifies that phrase. However, should the Examiner refuse to relent on this point, the Applicant would consent to an amendment to specifically note that – the pairs of uprights are spaced – "at fixed intervals."

§ 112 Rejections. The single fixed spacing interval in claim one is not indefinite. Claim one recites a stripping with a plurality of pairs of uprights on a single spacing interval, the pairs being adapted to receive a single specified size of framing member. Claim 1 does not recite multiple spacing units or the ability to receive multiple sizes of framing members; those features are recited in claim 6. "The construction element" in line 8 of claim one is proper because it refers back to a construction element earlier referred to in the whereby clause. The construction element at issue would be selected from the group of elements described on page 1 at lines 13 and 14. Objections to claim two are overcome by the following amendments.

Title of the Invention –

Add the words "Having a Plurality of Pairs of Uprights Thereon" at the end of the title of the invention.

TITLE OF THE INVENTION

B1 Construction Layout Stripping Having A Plurality Of Pairs Of Uprights Thereon